

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 1-5, 8 and 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - With respect to claim 1 the phrase “wherein the filler has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%” is rejected as it is unclear what the desired 200% absorbency of the package is relative too, i.e. relative to a package without any filler, a package of different volumes of a single filler, a package of different volumes of different fillers or if the desired absorbency due to the volume provided of a filler, due to the specific type of filler and/or due to the grain size of the filler. The phrase is further rejected due to the fact that an “absorbency rate” is with respect to a time, and thus the phrase is phrase “wherein the filler has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%” is further rejected since there is no defined time frame with respect to the absorbency rate.
 - The phrase “wherein the filler has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%” is further rejected since it is unclear if the water absorbency rate of the package is with respect to prior to the package prior to the soluble material absorbing water, during the soluble material absorbing water, or after all of the soluble material has passed through the package.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1-5, 8, 10-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Stipp (5554400).

Stipp teaches a beverage portioned package and a method for making a beverage portioned package (title) for preparing a beverage in an extraction device (col. 8 lines 30-35) in which the package is held between a water supplying part and a receiver of the device (col. 8 lines 30-35). More specifically Stipp teaches with respect to claim 1 a first surface for receiving water and allowing the water to flow into and through the package (col. 8 lines 14-29, col. 7 lines 63-65) under pressure when the package is operatively associated with the extraction device to form the beverage (col. 8 lines 30-35), a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device (col. 8 lines 14-29, col. 7 lines 63-65), where it is noted that Stipp teaches a sheet folded over and attached along three sides. In addition, the package contains a water-soluble beverage material in an amount sufficient to form the beverage (col. 9 lines 24-27, col. 11 line 37) and a filler comprising a water insoluble material (col. 3 lines 30-60) adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (col. 9 lines 32-37), and that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37) thus providing a filler which has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%.

It is noted that Stipp teaches a filler which, as is claimed by applicant, in a preferred embodiment is specifically ground coffee (col. 3 lines 23-60). It is further noted that column 9 lines 24-28, col. 9 lines 10-12 of Stipp teaches that the water-soluble material comprises ground coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage, that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37) and that the water-soluble material includes soluble coffee powder, milk powder, a creamer substitute

powder or mixtures thereof (col. 9 lines 25-26, col. 4 lines 1-60). Therefore since it would be expected that the filler, which is ground coffee, as is claimed and taught by Stipp would provide the same naturally properties, and more specifically since Stipp does teach the same referenced materials, at applicant's desired ratio by volume, Stipp is taken to positively teach that the filler has water absorbent properties that are sufficient to provide a package having absorbency rate of at least 200%, and that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37).

Stipp continues by teaching with respect to claims 2-4 that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37), that the pressure resistance bed extends through the entire package (col. 15 lines 18-21), and that the pressure resistance bed comprises discrete pieces of the filler in the form of particulates, granules, flakes, fibers or combinations thereof (col. 9 lines 7-10, col. 3 lines 30-60). Stipp further teaches that the pressure resistance bed comprises at least one continuous porous piece in the form of a compacted piece (col. 8 lines 31-63), that the filler comprises a water-absorbent material which includes fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60), that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (col. 9 lines 24-28, col. 9 lines 10-12) and that the water-soluble material includes soluble coffee powder, milk powder, a creamer substitute powder or mixtures thereof (col. 9 lines 25-26, col. 4 lines 1-60).

Stipp further teaches a soluble or water extractable substance for aromatizing or flavoring the beverage (col. 5 lines 21-42), where the soluble or extractable substance is an aroma, coffee, an artificial flavor or a natural flavor (col. 5 lines 21-42), that the first and second surfaces are walls made of a water-permeable material (col. 8 lines 25-31), and specifically filter paper sheets (col. 8 line 54) or plastic (col. 7 line 67) which has semi-solid walls which are pre-opened (col. 7 line 65). In addition, Stipp teaches the addition of a foaming creamer (col. 14 lines 59-60) yielding a beverage having a high foamed head (col. 15 line 3).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 1-4, 8 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cai (20030096038) in view of Groen (EP1142483).

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid

comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line 47).

Cai further teaches the addition of a solubility promoter such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032).

However Cai is silent with respect to teaching the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties.

Groen teaches a coffee package (title). More specifically Groen teaches the addition of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee (par. 0007). Groen continues by teaching that the filler may be filtering paper, or cellulose fiber as a few examples (par. 0007), for absorbing water (par. 0010, ex. 2 and 3).

Therefore since the specific type of filler, the volume of filler, the size of the package and other unclaimed variables would affect the desired rate of absorbency of the package, one of ordinary skill in the art would have been motivated to have combine the teachings and taught providing a specific filler wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties since Cai teaches an infusion package comprising a soluble material and a filler and since Groen specifically teaches the use of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee (par. 0007), as opposed to being separated therefrom for promoting proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), as is desired by Cai.

Therefore since both Cai and Groen recognize the desire to provide an agent which absorbs water for its art recognized and applicant's intended purpose of promoting

proper dissolution of the solids (par. 0027), in addition to the pod further comprising a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), and since Groen specifically teaches, in one instance, applicant's desired filler material (par. 0007) it would have been obvious to one of ordinary skill in the art to teach a specific desired absorbency rate of the filler with respect to a package since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention.

Further since the claim is silent with respect to a volume provided of a filler, the specific type of filler and/or grain size of the filler, one of ordinary skill in the art would not expect the method of the instant claims to perform differently than the prior art methods, thus the claimed method is not patentably distinct from the prior art method (See MPEP 2144.04 IV A). "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation," (see MPEP 2144.05 IIA), as the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages" (see MPEP 2144.05 IIA) such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032) as is taught by Cai.

Therefore it would have been obvious to one of ordinary skill in the art to teach the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. It would have further been obvious

since combining the two methods, each of which is taught by the prior art to be useful for the same purpose of providing a beverage from an infusible substance, flows logically from their having been individually taught in the prior art (see MPEP 2144.06), and since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination.

- Claims 1-3, 5 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cai 20030096038 in view of Schmidt (3833740).

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line 47).

Cai further teaches the addition of a solubility promoter such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032).

However Cai is silent with respect to teaching the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties.

Schmidt teaches a coffee package (title). More specifically Schmidt teaches the addition of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee, such as a porous sponge like body which has no smell or taste for facilitating thorough wetting and more rapid and thorough extraction of roasted coffee (col. 3 lines 45-57)

Therefore since the specific type of filler, the volume of filler, the size of the package and other unclaimed variables would affect the desired rate of absorbency of the package, one of ordinary skill in the art would have been motivated to have combine the teachings and taught providing a specific filler wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties since Cai teaches an infusion package comprising a soluble material and a filler and since Schmidt specifically teaches the use of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee (col. 3 lines 45-54), as opposed to being separated therefrom for promoting proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), as is desired by Cai.

Therefore since both Cai and Schmidt recognize the desire to provide an agent which absorbs water for its art recognized and applicant's intended purpose of promoting proper dissolution of the solids (par. 0027), in addition to the pod further comprising a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), and since Schmidt specifically teaches, with respect to claim 5, applicant's desired filler material (par. 0007, it would have been obvious to one of ordinary skill in the art to teach a specific desired absorbency rate of the filler with respect to a package since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change

in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention.

Further since the claim is silent with respect to a volume provided of a filler, the specific type of filler and/or grain size of the filler, one of ordinary skill in the art would not expect the method of the instant claims to perform differently than the prior art methods, thus the claimed method is not patentably distinct from the prior art method (See MPEP 2144.04 IV A). "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation," (see MPEP 2144.05 IIA), as the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages" (see MPEP 2144.05 IIA) such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032) as is taught by Cai.

Therefore it would have been obvious to one of ordinary skill in the art to teach the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. It would have further been obvious since combining the two methods, each of which is taught by the prior art to be useful for the same purpose of providing a beverage from an infusible substance, flows logically from their having been individually taught in the prior art (see MPEP 2144.06), and since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination.

- Claims 1-8, 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kane (2110732) in view of Cai (6777007).

Kane teaches a beverage portioned package and a method for making a beverage portioned package (pg. 1 col. 2 lines 26-35) for preparing a beverage in an extraction device in which the package is held between a water supplying part and a receiver of the device (pg. 2 col. 2 lines 11-17) where it is noted that the water supplying part is interpreted as the water being poured and the cup is interpreted as the receiver where the package is on the receiver.

More specifically Kane teaches with respect to claim 1 a bag or sack for receiving water and allowing the water to flow into and through the package (pg. 1 col. 2 line 37) under pressure when the package is operatively associated with the extraction device to form the beverage (pg. 1 col. 2 line 37), that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device (pg. 1 col. 2 lines 63-65), where the package contains a water-soluble beverage material in an amount sufficient to form the beverage (pg. 2 col. 2 lines 11-17), a filler comprising a water insoluble material (pg. 1 col. 1 lines 25-35) adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (pg. 2 col. 1 lines 35-45, pg. 2 col. 2 lines 30-35), and that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (pg. 2 col. 2 lines 34-38).

It is noted that Kane teaches a filler which, as is claimed by applicant, is specifically "freshly roasted coffee" (pg. 2 col. 1 line 17). It is further noted that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (pg. 3 col. 2 lines 34-38) that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (pg. 2 col. 2 lines 34-38) and that the water-soluble material includes soluble coffee powder (pg. 3 col. 1 lines 54-56).

Therefore since it would be expected that the filler, which is fresh ground coffee, as is claimed and taught by Kane would provide the same naturally properties, and more specifically since Kane does teach the same referenced materials, at applicant's desired ratio by volume, Kane is taken to positively teach that the filler has water absorbent

properties that are sufficient to provide a package having absorbency rate of at least 200%, and that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37).

Kane continues by teaching with respect to claims 2-4 that the filler is present in an amount sufficient to form a pressure resistance bed (pg. 2 col. 2 lines 35-45), that the pressure resistance bed extends through the entire package (pg. 1 col. 2 lines 18-20), and that the pressure resistance bed comprises discrete pieces of the filler in the form of particulates, granules, flakes, fibers or combinations thereof (pg. 2 col. 1 lines 17-33). Kane further teaches that the filler comprises a water-absorbent material which includes fresh ground coffee, spent ground coffee or a combination thereof (pg. 2 col. 1 lines 18-32), that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (pg. 3 col. 2 lines 34-38) and that the water-soluble material includes soluble coffee powder (pg. 3 col. 1 lines 54-56).

Kane further teaches that the filler contains a soluble or water extractable substance for aromatizing or flavoring the beverage (pg. 1 col. 2 lines 31-35), where the soluble or extractable substance is an aroma, coffee, an artificial flavor or a natural flavor (pg. 1 col. 2 lines 31-35), that the first and second surfaces are walls made of a water-permeable material (pg. 1 col. 2 lines 37-39), which has semi-solid walls which are pre-opened (pg. 1 col. 2 lines 31-35).

However Kane is silent with regard to specifically stating that the bag or sack comprises a first surface for receiving water and allowing the water to flow into and through the package and a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device, in addition to being silent with respect to the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, that the first and second surfaces being disk-shaped sheets, a sealing seam for interconnecting the filter paper, and processing the package in an extraction device thus facilitating the formation of a foam on the beverage where the material is filter paper or plastic.

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials

which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line 47).

Therefore, although Kane does not teach the placement of the beverage package within an extraction device where the resultant beverage contains foam due to the pressure of the water being introduced into the package, Kane does teach all of the limitations with regard to the beverage portioned package, in addition to teaching pouring water over the package while in a receiver (pg. 2 col. 2 lines 15-16) where Cai teaches the desire to provide a seam which can be long enough to function as a handle (col. 6 lines 20-22) and thus one of ordinary skill in the art would have been motivated to combine the teaching of Kane and Cai since providing an automatic or mechanical means to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art (see MPEP 2144.04III).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have made or produced a beverage package containing both soluble and insoluble materials that is placed in an extraction device to produce a foamy beverage in order to more accurately control the amount of liquid, the strength and to provide a more timely manner of obtaining a coffee drink as is desired by Cai (col. 2 lines 55-63).

Further although Kane is silent with respect to the specific shape of the package or that the package is specifically filter paper or plastic, Kane does teach a bag manufactured from water permeable paper and thus one skilled in the art could have used specifically a disc shaped filter paper with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. Therefore, since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination it would have been obvious to one of ordinary skill in the art to teach a specific shape or a specific type of material which allows the product to diffuse there through as is desired by Kane, which is specifically disc shaped since Cai specifically teaches the sealing seam being long enough to function as a handle for the pod (col. 6 lines 20-22) in addition to teaching that the pod can adopt various shapes and materials (col. 5 lines 45-48) in addition to specifically teaching a disc shape (col. 6 line 38, fig. 4).

With respect to Kane being silent that the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, Kane does desire to provide a pressure resistant bed (pg. 2 col. 2 lines 35-45) and thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Kane and Cai and produce a beverage package containing soluble and insoluble materials that is used in an extraction device to make a foamy coffee beverage further comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof in order to provide a package for use with an extraction machine for its art recognized and applicant's intended purpose of the providing a beverage pod that is sufficiently dried and drip-free right after preparing the beverage (col. 2 lines 65-68) thereby increasing its appeal to the consumer due to the cleanliness thereof making the product more desirable due to this advantage (col. 2 lines 57-68).

- Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stipp (5554400).

With respect to claim 17 Stipp is silent with respect to the first and second surfaces being disk-shaped sheets.

However Stipp teaches first and second surfaces manufactured from filter paper and interconnected adjacent their peripheral edges, with the interconnected parts of the

sheets forming an annular sealing seam to allow the package to be held in the extraction device (col. 8 lines 25-35) and thus one skilled in the art could have used specifically a disc shaped filter paper with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. Therefore, since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination and thus it would have been obvious to one of ordinary skill in the art to teach a specific shape, specifically disc shaped since Stipp specifically teaches adapting the “shape and design” of the bag with respect to the specific brewing method (col. 8 lines 33-35).

Response to Arguments

With respect to the phrase “a filler which has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%”, it is initially noted that applicant states the specification defines “water absorbency rate” with respect to the package “when emptied”, and compared to the initial package. However it is noted that claims 1 and 20 teach the package comprising the filler sufficient to provide a water absorbency rate of the package of at least 200%, which is different from claiming a “water absorbency rate of the package of at least 200%”, after the soluble material has passed through with respect to the initial package. Thus it is noted that the features upon which applicant relies (i.e., “water absorbency rate of the package of at least 200%” with respect to the package after the soluble product has passed through is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore it remains unclear what the desired 200% absorbency of the package is relative too.

In addition it is noted that applicant urges that the exact same material at the exact same claimed ratios of filler to soluble material as taught by Kane, Schmidt, and Groen would not be sufficient to provide a water absorbency rate of the package of at least 200%. Therefore if the same material at the same ratio in the package is not sufficient to provide a water absorbency rate of the package of at least 200%, as applicant urges, then it remains unclear if the filler being sufficient to provide a water absorbency rate of the package of at least 200%, is relative to a package without any filler, a package of different volumes of a single filler, a package of different volumes of different fillers or if the desired absorbency due to the volume provided of a filler, due to the specific type of filler and/or due to the grain size of the filler. It is further unclear due to the fact that an “absorbency rate” is with respect to a time,

and thus the phrase is phrase "wherein the filler has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%" is further unclear since there is no defined time frame with respect to the absorbency rate, where although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is initially noted that as what stated in the previous Office Action;

- Stipp teaches as is claimed by claim 1, a water soluble material, which is exactly the same as that as defined by applicants specification and as claimed by claims 11 and 12, i.e., the water-soluble material includes soluble coffee powder, milk powder, a creamer substitute powder or mixtures thereof (col. 9 lines 25-26, col. 4 lines 1-60), and more specifically teaches that the water-soluble material comprises applicants exact same soluble material in applicants exact same amount i.e., "that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage". Thus it is noted that Stipp teaches applicant's exact same soluble material in the exact same amount.
- With respect to the filler, Stipp further teaches not only applicant's claimed filler i.e., fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60) but Stipp further teaches applicant's exact claimed ratio of water-soluble material to filler i.e., between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37).

Therefore with respect to applicant arguments that Stipp is silent with respect to teaching providing a filler which has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%, since Stipp teaches the same defined materials, at applicants claimed ratio by volume, it would be expected that the filler, which is ground coffee, as is claimed and taught by Stipp would provide the same naturally properties, and more specifically since Stipp does teach the same referenced materials, at applicant's desired ratio by volume, Stipp is taken to positively teach that the filler has water absorbent properties that are sufficient to provide a package having absorbency rate of at least 200%. More specifically, that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37) at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (col. 9 lines 32-37) since once the package is emptied of the water-soluble material as is claimed, the package of Stipp and the package as claimed would both be packages emptied of the water-soluble material. Thus at the end of

brewing, i.e., dissolution of the water soluble material, the prior package of ratio of water-soluble material to filler i.e., between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume which is taught by Stipp (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37) would comprise the exact same resulting package as that claimed since both would comprise, applicant's claimed filler i.e., fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60) at applicant's exact claimed amount (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37)

As was urged in the previous Office Action, since applicant argues that the same claimed materials, at the same claimed ratios as that taught by Stipp, would achieve different and unexpected results and further since "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding Stipp not teaching applicants intended water absorbancy, in light of Stipp specifically teaching the same referenced materials at applicants desired ratio by volume, must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001", in light of the fact that in the instant case applicant maintains that although Stipp teaches the same filler, at the ratio, that this same filler, at the same ratio is not adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (col. 9 lines 32-37) since both would comprise the exact same resulting package as that claimed since both would comprise, applicant's claimed filler i.e., fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60) at applicant's exact claimed amount (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37) "when the package is emptied of the water-soluble material".

With respect to applicant arguments that Stipp is silent to teaching that "the filler is configured to decrease the pressure drop during extraction to less than .2 bars, and that the bag is sized to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, since applicant urges that Stipp teaches "dunking", and is "more akin to a tea bag", applicant is urged to column 9 lines 59-62 which specifically teaches "placing the infusion product in a percolator or automatic drip-type coffee maker". Therefore it is once again noted that Stipp teaches applicants same claimed package comprising applicants same claimed materials

at applicant's same claimed ratios, in applicant's same claimed "extraction device" for achieving an infusion beverage product.

In response to applicant's arguments against Kane, Cai I, Cai II, Schmidt and Groen individually it is noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Specifically with respect to Kane as the primary reference, and applicants argument that Kane is silent with respect to teaching a first surface for flowing water into the package and a second surface which is different to allow the beverage to flow out, or that the water is introduced into the package under pressure, it is initially noted that in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a first surface for flowing water into the package and a second surface which is different to allow the beverage to flow out) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

However it is noted that the rejection is in view of Cai ('007), and thus although Kane is silent with regard to specifically stating that the bag or sack comprises a first surface for receiving water and allowing the water to flow into and through the package and a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of extraction device, Kane positively teaches "pouring the water over the surface". Therefore, although Kane does not teach the placement of the beverage package within an extraction device Kane does teach all of the limitations with regard to the beverage portioned package, in addition to teaching pouring water over the package while in a receiver (pg. 2 col. 2 lines 15-16).

Thus since Kane teaches pouring the water onto the package thus introducing the water under pressure, and since Kane positively teaches as claimed that the bag or sack comprises a first surface for receiving water and allowing the water to flow into and through the package and a second surface that allows for the beverage to flow there through so that the beverage can be collected, and since both Kane and Cai teach coffee portioned packages for receiving water, one of ordinary skill in the art would have been motivated to combine the teaching of Kane and Cai since providing an automatic or mechanical means to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art (see MPEP 2144.04III).

Further with respect to claim 20, which does not claim the first or second receiving surfaces, since Cai teaches that when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam. It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have made or produced a beverage package containing both soluble and insoluble materials that is placed in an extraction device to produce a foamy beverage as taught by Cai in order to more accurately control the amount of liquid, the strength and to provide a more timely manner of obtaining a coffee drink as is desired by Cai (col. 2 lines 55-63).

It is noted that Kane teaches a filler which, as is claimed by applicant, is specifically “freshly roasted coffee” (pg. 2 col. 1 line 17). It is further noted that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (pg. 3 col. 2 lines 34-38) that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (pg. 2 col. 2 lines 34-38) and that the water-soluble material includes soluble coffee powder (pg. 3 col. 1 lines 54-56).

Therefore since it would be expected that the filler, which is fresh ground coffee, as is claimed and taught by Kane would provide the same naturally properties, and more specifically since Kane does teach the same referenced materials, at applicant’s desired ratio by volume, Kane is taken to positively teach that the filler has water absorbent properties that are sufficient to provide a package having absorbency rate of at least 200%, and that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37).

Once again it is noted applicant argues that the same claimed materials, at the same claimed ratios as that taught by Kane, would achieve different and unexpected results and further since “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner’s position that the arguments provided by the applicant regarding Kane not teaching applicants intended water absorbancy, in light of Kane specifically teaching the same referenced materials at applicants desired ratio by volume, must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”, in light of the fact that in the instant case applicant maintains that although Kane teaches the same filler, at the ratio, that this same filler, at the same ratio is not adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage

material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (col. 9 lines 32-37) since both would comprise the exact same resulting package as that claimed since both would comprise, applicant's claimed filler i.e., fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60) at applicant's exact claimed amount (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37) "when the package is emptied of the water-soluble material".

With respect to applicant's argument that Cai (I) and Cai (II) being silent with respect to the extraction pressure or providing water absorbent materials capable of 200% water absorbency, it is noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the claims are rejected as Cai ('038) is in view of Groen, and in a separate rejection Cai ('038) in view of Schmidt, and in a separate rejection Kane in view of Cai II ('007).

With respect to applicant argument that Groen and Schmidt are silent to the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties, both teach applicants claimed Cai teaches a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032).

In response to applicant's argument that Cai teaches against applicant invention since Cai teaches layer it is noted that claim 5, and the specification specifically teaches the soluble material and the filler in separate layers while achieving applicant's desired pressure and water absorbency.

However it is further noted Groen specifically teaches the use of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee (par. 0007), as opposed to being separated therefrom for promoting proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), as is desired by Cai, thus it is noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is further noted that Groen is a secondary reference where Cai teaches the package itself, and thus with respect to applicants argument that Groen is silent to teaching the package other than the components, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Groen specifically teaches the use of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee (par. 0007), as opposed to being separated therefrom for promoting proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), as is desired by Cai, thus it is noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to applicant argument that Groen and Schmidt are silent to the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties, both teach applicants desired filler material, and Cai teaches a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032).

Thus since the claim is silent with respect to a volume provided of a filler, the specific type of filler and/or grain size of the filler, one of ordinary skill in the art would not expect the method of the instant claims to perform differently than the prior art methods, thus the claimed method is not patentably distinct from the prior art method (See MPEP 2144.04 IV A). "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation," (see MPEP 2144.05 IIA), as the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages" (see MPEP 2144.05 IIA) such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032) as is taught by Cai.

Therefore it would have been obvious to one of ordinary skill in the art to teach the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. It would have further been obvious since combining the two methods, each of which is taught by the prior art to be useful for the same purpose of providing a beverage from an infusible substance, flows logically from their having been individually taught in the prior art (see MPEP 2144.06), and since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination.

In addition, since all recognize the desire to provide an agent which absorbs water for its art recognized and applicant's intended purpose of promoting proper dissolution of the solids (par. 0027), in addition to the pod further comprising a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), and since Schmidt and Groen specifically teach, in one instance, applicant's desired filler materials, it would have been obvious to one of ordinary skill in the art to teach a specific desired absorbency rate of the filler with respect to a package since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Drew E Becker/

Primary Examiner, Art Unit 1782

/Steven Leff/

Examiner, Art Unit 1794